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EXAMINER
HUNTSINGER, PETER K

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/676,984	FERLITSCH, ANDREW R.
	Examiner	Art Unit
	Peter K. Huntsinger	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 June 2009</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/22/09

has been entered.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-25 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Warmus '149 in view of Simpson '803, Sinofsky '178 and Smith '162.

Referring to **claim 1**, Warmus '149 discloses in an image rendering environment, a method for dynamically adding one or more document indicia to a document when rendering the document, the method comprising:

providing a rendering job in a native format that supports at least one of (i) multiple pages, and (ii) multiple images (col. 7, lines 1-6, page description language);

storing one or more document indicia (col. 9, lines 57-61, personalized information, variable image, or the like) as separate sub-images in a native format (col. 7, lines 1-6, variable page files);

correlating one or more pages of the document with one or more of the sub-images (col. 7, lines 24-36, master and variable page files merged);

defining an ordered subset of the sub-images to apply to the document (col. 7, lines 6-10, press command file specifies the manner in which the master and variable files are to be merged);

wherein a rendering device:

receives the single file in the native format (col. 23, lines 21-35, process the TIFF file for printing); and

renders the rendering job, wherein the one or more sub-images are rendered as parts of the one or more pages of the document based on an association process, wherein the association process is one of (i) an overlay process, (ii) an underlay process, and (iii) a composite process (col. 20, lines 1-10, overlay the variable pages on the master pages).

Warmus '149 does not disclose expressly rendering the document without using a printer driver.

Simpson '803 discloses rendering a document without using a printer driver (col. 1, lines 39-51, computer generates a print job without the use of a print driver).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to generate a document without using a printer driver. The motivation for doing so would have been to eliminate the need to specifically configure a computer to make use of many printers.

Warmus '149 does not disclose expressly storing separate sub-images in the single file.

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files); and

providing links within the file linking one or more pages of the document with one or more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and 122 to other files).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to incorporate multiple files into one comprehensive file and provide links within that file. The motivation for doing so would have been to maintain the integrity of the comprehensive file.

Warmus '149 does not disclose expressly linking a first sub-image with a second sub-image, and rendering the second sub-image as part of first sub-image.

Smith '162 discloses linking a first sub-image with a second sub-image (col. 10, lines 35-47, storing the identifier of the parent object is sufficient to link the list to the subordinate "offspring" object), and

wherein the second sub-image is rendered as part of the first sub-image which is rendered as part of one of the pages of the document (col. 14, lines 45-59, content object containing text, image or graphic content can be a block object within a frame object) (col. 2, lines 61-64, objects are assembled and printed).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to render a second sub-image as part of a first sub-image. The motivation for doing so would have been to facilitate modular construction of complex documents with considerable flexibility. Therefore, it would have been obvious to combine Simpson '803, Sinofsky '178 and Smith '162 with Warmus '149 to obtain the invention as specified in claim 1.

Referring to **claim 2**, Warmus '149 discloses wherein the native format is one of:

(i) a tagged image file format; and

(ii) a portable document format (col. 4, lines 21-31, TIFF file).

Referring to **claim 3**, Warmus '149 discloses wherein the document indicia is disbound from page data of the rendering job (col. 20, lines 1-10, overlay the variable pages on the master pages).

Referring to **claim 4**, Warmus '149 discloses wherein correlating one or more pages of the document with one or more of the sub-images comprises a linking the one

or more pages in a next list (col. 7, lines 6-10, press command file specifies the manner in which the master and variable files are to be merged).

Sinofsky '178 discloses linking one or more pages of the document with one or more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and 122 to other files).

Referring to **claim 5**, Warmus '149 discloses wherein correlating one or more pages of the document with one or more of the sub-images comprises a sub-chaining the one or more sub-images from page images by a sub list (col. 7, lines 6-10, press command file specifies the manner in which the master and variable files are to be merged).

Sinofsky '178 discloses linking one or more pages of the document with one or more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and 122 to other files).

Referring to **claim 6**, Warmus '149 discloses wherein correlating one or more pages of the document with one or more of the sub-images comprises sub-chaining the one or more sub-images within sub-images (col. 11-12, lines 62-67, 1-22, object inserted defined by curser, user can insert multiple objects).

Sinofsky '178 discloses linking one or more pages of the document with one or more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and 122 to other files).

Referring to **claim 7**, Warmus '149 discloses wherein defining an ordered subset of the sub-images comprises creating a set of instructions in one of

(i) a dynamic manner, and

(ii) a static manner (col. 20, lines 49-54).

Referring to **claim 9**, Warmus '149 discloses wherein all the sub-images are in the native format (col. 4, lines 21-31, TIFF file).

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files).

Referring to **claim 11**, Warmus '149 discloses wherein the native format is an image format (col. 4, lines 21-31, TIFF file).

Referring to **claim 12**, Simpson '803 discloses wherein rendering the rendering job occurs within a printing device rendering and printing the document without rasterization (col. 1, lines 39-51, computer generates a print job without the use of a print driver).

5.   Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus '149, Simpson '803, Sinofsky '178 and Smith '162 as applied to claim 1 above, and further in view of Janse '434.

Referring to **claim 8**, Warmus '149 discloses wherein the one or more sub-images are placed at one or more locations of the one or more pages of the document and at one or more scales defined by information, the information being defined independently of the pages of the document (col. 20, lines 17-23, instruction set specifying how the pages should be positioned is incorporated into press command file 140).

Warmus '149 does not disclose expressly storing the location and scale
information within the single document file.

Janse '434 discloses a single document file containing print setting information
(Fig. 6, col. 7, lines 23-37, TIFF file comprises tear-off part 37 which defines print
settings).

At the time of the invention, it would have obvious to a person of ordinary skill in
the art to incorporate print setting information into one comprehensive document file.
The motivation for doing so would have been to provide easier methods of handling,
processing and archiving the single file. Therefore, it would have been obvious to
combine Janse '434 with Warmus '149 to obtain the invention as specified in claim 8.

6.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus
'149, Simpson '803, Sinofsky '178 and Smith '162 as applied to claim 1 above, and
further in view of well known prior art.

Referring to **claim 10**, Warmus '149 discloses wherein the overlay process
includes applying an overlay on top of one of:

(i) a page image; and

(ii) another sub-image (col. 20, lines 1-10, overlay the variable pages on the
master pages).

Warmus '149 does not disclose expressly applying an underlay process.

Official Notice is taken that it is well known and obvious in the art to apply an
underlay (See MPEP 2144.03). The motivation for doing so would have been to retain

the information of the master page of the overlapping region as opposed to the variable

page. Therefore it would have been obvious to combine well known prior art with

Warmus '149 to obtain the invention as specified in claim 10.

7.   Claims 13, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Warmus '149 in view of Wu '767, and Venable '983.

Referring to **claim 13**, Warmus '149 discloses in a printing environment, a

method for adding document indicia when printing an image, the method comprising:

using a multi-subfile extension (Fig. 5, col. 11, lines 18-29, file 130 includes file

portions) to represent multiple sub-images of a TIFF image within a single TIFF

document file, wherein data of the TIFF image is not converted into printing instructions

by an application (col. 23, lines 21-23, files 122, 137, and 138 preprocessed to TIFF

format);

using an extension to group and locate the sub-images on a page (Fig. 5, col. 11,

lines 18-29, file 130 includes file portions);

performing at least one of:

supporting an overlay of the multiple sub-images on the page (col. 20, lines 1-10,

overlay the variable pages on the master pages).;

supporting an underlay of the multiple sub-images on the page;

supporting a composite of the multiple sub-images on the page;

specifying a merge order of the multiple sub-images on the page;

specifying a location for merging the multiple sub-images on the page; and

specifying any scaling of the multiple sub-images; and

selectively rendering the TIFF image based on the electronic tags (col. 23, lines

21-35, process the pages for printing).

Warmus '149 does not disclose expressly rendering the document without using

a printer driver.

Wu '767 discloses printing an image without the use of a printer driver;

providing the single TIFF document file to a printer in TIFF format without using a

printer driver; and

selectively rendering the TIFF image at the printer (col. 3, lines 18-35, image

data such as a TIFF file may be directly printed without external software).

At the time of the invention, it would have obvious to a person of ordinary skill in

the art to generate a document without using a printer driver. The motivation for doing

so would have been to reduce the processing required for printing.

Warmus '149 discloses merging images onto a page but does not disclose

expressly using electronic tags of a TIFF document file.

Venable '983 discloses using electronic tags of a TIFF document file; and

merging sub-images based on the electronic tags (col. 13-14, lines 48-67, 1-5,

merge tags specify merging objects).

At the time of the invention, it would have obvious to a person of ordinary skill in

the art to utilize electronic tags to merge images. The motivation for doing so would

have been to utilize a format that has minimal memory requirements but produces high

resolution, high quality printed images. Therefore, it would have been obvious to

combine Wu '767 and Venable '983 with Warmus '149 to obtain the invention as
specified in claim 13.

Referring to **claim 15**, Warmus '149 discloses specifying both a location for
merging the multiple sub-images on the page and scaling of the multiple sub-images
(col. 20, lines 17-23, instruction set specifying how the pages should be positioned is
incorporated into press command file 140).

Venable '983 discloses using electronic tags of a TIFF document file (col. 13-14,
lines 48-67, 1-5, merge tags specify merging objects).

Referring to **claim 18**, see the rejection of claim 10 above.

8.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus
'149, Wu '767 and Venable '983, as applied to claim 13 above, and further in view of
Smith '162.

Referring to **claim 14**, Smith '162 discloses wherein the overlay is applied on top
of another sub-image that is merged with a page image(col. 14, lines 45-59, content
object containing text, image or graphic content can be a block object within a frame
object) (col. 2, lines 61-64, objects are assembled and printed).

At the time of the invention, it would have obvious to a person of ordinary skill in
the art to render a second sub-image as part of a first sub-image. The motivation for
doing so would have been to facilitate modular construction of complex documents with
considerable flexibility. Therefore, it would have been obvious to combine Smith '162
with Warmus '149 to obtain the invention as specified in claim 14.

9.   Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Warmus '149, Wu '767 and Venable '983, as applied to claim 13 above, and further

in view of well known prior art.

Referring to **claim 16**, see the rejection of claim 10 above.

Referring to **claim 17**, Warmus '149 discloses adding document indicia to a

document but does not disclose expressly a watermark.

Official Notice is taken that it is well known and obvious in the art to utilize a

watermark when printing a document (See MPEP 2144.03). The motivation for doing

so would have been to protect a document from counterfeit. Therefore it would have

been obvious to combine well known prior art with Warmus '149 to obtain the invention

as specified in claim 17.

10.   Claims 19, 20 and 22-25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Warmus '149 in view of Simpson '803, Sinofsky '178 and Venable

'983.

Referring to **claim 19**, Warmus '149 discloses a computer readable medium

storing a computer program product for implementing within a computer system a

method for dynamically adding one or more document indicia to a document when

rendering the document, the computer program product comprising computer program

code means utilized to implement the method, wherein the computer program code

means is comprised of executable code for:

receiving a rendering job of a document at a rendering device, where the rendering job is in a native format that supports at least one of (i) multiple pages, and (ii) multiple images (col. 7, lines 24-54, the master and variable page files are converted into bitmaps and are sent to the printer), and wherein the rendering job contains:

one or more document indicia (col. 9, lines 57-61, personalized information, variable image, or the like) stored as separate sub-images in a native format (col. 7, lines 1-6, variable page files), wherein the one or more images are defined independently of and are not merged with the one or more sub-images (col. 20, lines 1-10, master pages 122);

defining how the one or more pages of the document should be merged with one or more of the sub-images (col. 7, lines 6-10, press command file specifies the manner in which data contained within the master and variable page files are to be merged to produce printed pages); and

an ordered subset of the sub-images to apply to the document (col. 7, lines 6-10, press command file specifies the manner in which data contained within the master and variable page files are to be merged to produce printed pages); and

using a rendering device process to associate and merge the one or more sub-images with one or more of the pages of the document when rendering the document, wherein the process is one of (i) an overlay process, (ii) an underlay process, and (iii) a composite process (col. 20, lines 1-10, overlay the variable pages on the master pages).

Warmus '149 does not disclose expressly rendering the document without using

a printer driver.

Simpson '803 discloses rendering a document without using a printer driver (col.

1, lines 39-51, computer generates a print job without the use of a print driver).

Warmus '149 does not disclose expressly a rendering job of a document as a

single file containing pages and indicia.

Sinofsky '178 discloses a single file document containing separate sub-images

(col. 3, lines 6-19, compound document that contains sub-files).

At the time of the invention, it would have obvious to a person of ordinary skill in

the art to incorporate multiple files into one comprehensive file. The motivation for

doing so would have been to maintain the integrity of the comprehensive file.

Warmus '149 discloses merging images onto a page but does not disclose

expressly using tags of a document.

Venable '983 discloses one or more tags within the file defining how one or more

pages of the document should be merged (col. 13-14, lines 48-67, 1-5, merge tags

specify merging objects).

At the time of the invention, it would have obvious to a person of ordinary skill in

the art to utilize electronic tags to merge images. The motivation for doing so would

have been to utilize a format that has minimal memory requirements but produces high

resolution, high quality printed images. Therefore, it would have been obvious to

combine Simpson '803, Sinofsky '178 and Venable '983 with Warmus '149 to obtain the

invention as specified in claim 19.

Referring to **claim 20**, see the rejection of claim 2 above.

Referring to **claim 22**, Warmus '149 discloses wherein the one of the sub-images is merged with each of the images forming the pages of the document (col. 12, lines 2-14, block 154 of Fig. 9).

Referring to **claim 23**, Warmus '149 discloses wherein the other sub-images are selectively merged with the images forming the pages of the document (col. 12, lines 2-14, block 154 of Fig. 9).

Referring to **claim 24**, Venable '983 discloses wherein the native format is a tagged image file format and the sub-images are placed at a location of the pages of the document and at a scale defined by tags included in an image file directory of the single file, the tags therefore being defined independently of the pages of the document defined by the tagged image file format (col. 13-14, lines 48-67, 1-5, merge tags specify merging objects) (col. 6-7, lines 50-67, 1-25, each child is merged at a location defined as Merge Point).

Referring to **claim 25**, Venable '983 discloses where the tags define different scales and placements of a single sub-image within multiple images and pages of the rendering job (col. 6-7, lines 50-67, 1-25, each child is merged at a location defined as Merge Point).

11.   Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus '149 Simpson '803, Sinofsky '178 and Venable '983 as applied to claim 19 above, and further in view of Smith '162.

Warmus '149 discloses merging sub-images but does not disclose expressly merging one sub-image into another sub-image.

Smith '162 discloses wherein the process associates and merges one or more of the sub-images into another sub-image to form a composite sub-image and merges the composite sub-image with one or more pages of the document (col. 14, lines 45-59, content object containing text, image or graphic content can be a block object within a frame object) (col. 2, lines 61-64, objects are assembled and printed).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to render a second sub-image as part of a first sub-image. The motivation for doing so would have been to facilitate modular construction of complex documents with considerable flexibility. Therefore, it would have been obvious to combine Smith '162 with Warmus '149 to obtain the invention as specified in claim 21.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/
Examiner, Art Unit 2625

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